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D-1108

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
David T. Frederick)	Art Unit: 3651
)	
Serial No.: 09/288,685)	Patent Examiner:
)	Jeffrey Shapiro
Filed: April 9, 1999)	
)	
For: Medical Cabinet With)	
Adjustable Drawers)	

Commissioner for Patents
Washington, D.C. 20231

Sir:

Reconsideration and withdrawal of the restriction requirement dated February 12, 2001 is respectfully requested.

Applicants Provisionally Elect With Traverse

In response to the Office Action ("Action") dated February 12, 2001 requiring restriction election, Applicant provisionally elects with traverse Group I (claims 1-19 and 40-56).

However, as discussed in more detail below, the restriction requirement is defective. Thus, Applicant has not been given a proper opportunity to respond to the restriction requirement.

The Restriction Requirement Is Defective

The Alleged Groups

In the Action inventions were alleged as Groups:

- I. Claims 1-19 and 40-56, drawn to a medical cabinet.
- II. Claim 20, drawn to a method of using a cabinet.
- III. Claims 21-23, drawn to a method of using a cabinet.
- IV. Claims 24-28, drawn to a method of using a cabinet.
- V. Claims 29-36, drawn to a medical cabinet.
- VI. Claims 29 and 37-39, drawn to a computer controlled medical cabinet.

Reasons For Insisting On Restriction Have Not Been Provided

In making a restriction requirement, it is understood that the initial burden is on the Office to establish a *prima facie* case that: (a) the claimed inventions are independent or distinct and (b) there would be a serious (or undue) burden on the examiner if restriction is not required (MPEP § 803).

Furthermore, MPEP § 808 indicates that with regard to every requirement to restrict the Office has the burden of showing two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween.

It is respectfully submitted that these burdens have not been met.

The Action Lacks Examples Of Distinctness Between All Alleged Groups

The Action, as best understood, relies on MPEP § 806.05, MPEP § 806.04, and MPEP § 808.01. However, MPEP § 806.05 clearly states that “The burden is on the examiner to provide reasonable examples that recite material differences.” Furthermore, “If applicant proves or provides convincing argument that there is no material difference or in the case of a process that cannot be performed by hand (if examiner so argued), the burden is on the examiner to document another materially different process or apparatus or withdraw the requirement.”

Thus, the Office is required to provide reasonable examples that recite material differences between each respective alleged Group. It is respectfully submitted that the Action only refers to Groups I/II, I/III, I/IV, V/IV, and V/VI. The Action has not shown, by way of any example, distinctness between the alleged Groups I/V, I/VI, II/III, II/IV, II/V, II/VI, III/IV, III/V, III/VI, and IV/VI. It follows that no reasonable examples have been provided, as is required to sustain the requirement. Therefore, restriction of the alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, it is not proper to require Applicant to make an election based on a defective, lacking, and incomprehensible restriction requirement.

Groups I and II-IV are not distinct

The Action alleged that the Groups are distinct, each from the other because “the processes outlined in groups II-IV can be practiced by another and materially different apparatus having an enclosure with slots in the side to allow for the selective hanging of drawers, shelves, or other equipment.”

The Applicant disagrees. The Action has not shown any example (evidence) of a materially different apparatus by which the process may be practiced, as is required. The processes each require the apparatus recited in claim 19. Apparatus claim 19 has been grouped with Group I. How can the processes (Groups II-IV) be practiced by another materially different apparatus than from Group I when the apparatus actually recited in the processes is from Group I? That is, Groups I-IV have the same apparatus (claim 19). Hence, Groups II-IV cannot be practiced without the Group I apparatus features (of claim 19).

Furthermore, it is not seen how the processes “can be practiced by another materially different apparatus” when both the processes and the apparatus are all directed to a “cabinet” as admitted in the Action.

The Action also alleges that the processes may be practiced “by hand.”

Applicant strongly disagrees. As previously discussed, the processes each require the Group I apparatus features (of claim 19) in order to perform the processes. Said apparatus

features are a part of the recited processes. That is, process steps require the apparatus structure of claim 19. It is unclear how a hand can constitute the recited apparatus structure of claim 19. Applicant requests a statement as to how this incredible act could be accomplished. It follows that the processes cannot be wholly completed by hand. Hence, the processes cannot be practiced “by hand.” Furthermore, the Action’s mere statement that the processes may be practiced “by hand” is not evidence that the alleged Groupings are distinct.

The Action also alleges that the apparatus “may be used to practice another and materially different process such as another combination of placement of items in the cabinet structure.”

The Applicant disagrees. This is not a legally valid basis for restriction. The Action admits that both the processes and the apparatus are each directed to “cabinet structure.” No showing of “another and materially different process” has been provided. As previously discussed, the processes (Groups II-IV) each require the Group I apparatus cabinet structure features (of claim 19) in order to perform the processes. Thus, the “cabinet structure” in the processes (Groups II-IV) is not materially different than the “cabinet structure” in the apparatus (Group I). How can another process which includes the Group I structure be materially different from the processes of Groups II-IV which also include the Group I structure? That is, if the apparatus cabinet structure of Group I is also used in another process, then that other process cannot be materially different from the processes of Groups II-IV which also include the apparatus cabinet structure of Group I.

Because the Action fails to provide any examples (evidence) of “another and materially different process”, Applicant has been required to speculate as to possible rationales for the restriction.

“If Applicant proves or provides convincing argument that there is no material difference or in the case of a process that cannot be performed by hand (if examiner so argued), the burden is on the examiner to document another materially different process or apparatus or withdraw the requirement” (MPEP § 806.05(e)). Applicant, in the reasons presented above, has shown that there is no material difference and that the process cannot be performed by hand. Therefore, it is respectfully requested that the restriction requirement should be withdrawn.

Groups V and IV are not distinct

The Action alleged that the Groups V and IV are unrelated.

The Applicant disagrees. The Action states that Group IV is drawn to a method of using a cabinet. The Action also states that Group V is drawn to a medical cabinet. Hence, the Action admits that both the process (Group IV) and the apparatus (Group V) are each directed to a “cabinet.” How is it possible that the “cabinet” in the Groups is not related?

The cited section of MPEP § 808.01 indicates that the situation of independent inventions (i.e., unrelated inventions) is rare. The cited section of MPEP § 806.04 provides an example of independent inventions as being a shoe and a locomotive bearing. How is a cabinet not related to a cabinet? The restriction requirement is without basis. Therefore, it is respectfully requested that the restriction requirement should be withdrawn.

Groups V and VI are not distinct

The Action alleged that Groups V and VI are “different”, despite the linking claim 29, because claim 39 of Group VI is directed towards a medical cabinet with computer-controlled access.

The Applicant disagrees. “Different” does not constitute “distinct” (MPEP § 806(C)). The Action never alleges that Groups V and VI are “distinct.” Nor have any reasonable examples been provided for insisting on restriction.

It is incomprehensible how claim 39 (which depends from claims 38/37/29) makes Groups V and VI “distinct.” No reasons have been provided, as is required to sustain the restriction requirement (MPEP § 808). The requirement merely states that claim 39 is directed towards a medical cabinet with computer-controlled access. So. What about the other claims in Groups V and VI? What about claims 38, 37, and 29 from which claim 39 depends?

The apparatus Groups V and VI are not distinct. Independent claim 29 is common to each Group. The Action has not established any distinctness. For example, the Action has not shown that the Groups are related as combination and subcombination (MPEP § 806.05(c)). Nor has the Action shown that the Groups are related as subcombinations disclosed as usable together in a single combination (MPEP § 806.05(d)). Therefore, it is respectfully requested that the restriction requirement should be withdrawn.

It is also noted that the Office is to use Form Paragraph 8.12 to make a restriction involving a linking claim (MPEP § 809.03) in order to notify Applicant that should a linking

claim be allowed, then the restriction requirement must be withdrawn (MPEP § 809). However, said Paragraph has not been used, nor has Applicant been notified on the record by the Office.

Other comments

It is noted that original claims 1-39 were already examined on the merits. That is, the Office previously determined that no restriction requirement existed in said claims. However, the Office now alleges that it acted in error and that restriction exists. These claims are now alleged to relate to distinct Groups I, II, III, IV, V, and VI. Nevertheless, the Office's prior admission that no restriction existed is further evidence that no restriction currently exists.

Furthermore, the Action has not addressed the issue of rejoinder of claims.

The Restriction Requirement Is Without Legal Basis

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being "distinct." The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both "independent" and "distinct." The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

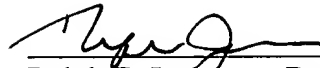
Furthermore the Patent Office has acknowledged that before claimed inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. All the claims directed to Applicants’ invention are related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.

Conclusion

The restriction requirement is respectfully traversed. None of the alleged Groups are distinct from any of the other alleged Groups. Therefore, it is respectfully requested that the restriction requirement be withdrawn.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner’s convenience.

Respectfully submitted,



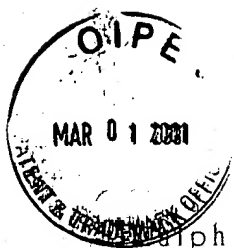
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Attn: Art Unit 3651
Patent Examiner Jeffrey Shapiro

Re: Application Serial No.: 09/288,685
Applicant: David T. Frederick
Title: Medical Cabinet With Adjustable Drawers
Docket No.: D-1108

Sir:

Please find enclosed Applicant's Response to the Office Action dated February 12, 2001
for filing in the above identified Application.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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